

REMARKS

Claims 66, 72, 88, 91, 105, 106 and 109-120 are pending; claims 66, 88, 105, 106, 109, 110, 117 and 118 are allowed; claims 72 and 91 are rejected; claims 111-116, 119 and 120 are objected to.

Support for the amendment to claim 91 may be found at page 24, lines 15-22.

No new matter has been added. Entry of the Amendment is respectfully requested.

I. Claim Objections

At paragraph 7 of the Office Action, claims 111 and 112 have been objected to as not including the word “and” between steps (a) and (b).

Included herewith is an amendment to claims 111 and 112 such that the word “and” has been inserted between elements (a) and (b) of claims 111 and 112. In view of the amendment to the claims, Applicants respectfully request reconsideration and withdrawal of this objection.

II. Claim Rejections - 35 U.S.C. §112

At paragraph 8 of the Office Action, claim 91 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that it is unclear whether the proviso “wherein said isolated or purified polypeptide has RNA primase activity” refers to both elements (a) and (b), or to element (b) alone. The Examiner notes that he has interpreted the proviso to apply to both elements (a) and (b).

Applicants note that the Examiner is correct in that the proviso applies to both elements (a) and (b). Included herewith is an amendment to claim 91 to more clearly recite the subject matter encompassed within the scope of the claim.

In view of the amendment, claim 91 is definite and Applicants respectfully request reconsideration and withdrawal of this rejection.

III. Claim Rejections - 35 U.S.C. §102

At paragraph 9 of the Office Action, claim 72 has been rejected under 35 U.S.C. §102(b) as being anticipated by O'Donnell (WO 99/37661).

The Examiner notes that claim 72 recites a polypeptide comprising SEQ ID NO:6 as the carboxy-terminal end of the polypeptide, and that the polypeptide binds SEQ ID NO:4.

The Examiner states that O'Donnell teaches a polypeptide that has a carboxy-terminal sequence (amino acids 534-572) that is 100% identical to SEQ ID NO:6. The Examiner further states that while O'Donnell fails to teach whether the disclosed polypeptide binds SEQ ID NO:4, because the present specification teaches that a polypeptide having SEQ ID NO:6 at the carboxy-terminus binds to SEQ ID NO:4, in the absence of evidence to the contrary the polypeptide of O'Donnell would be expected to bind SEQ ID NO:4.

Applicants respectfully traverse the rejection as the Examiner has not demonstrated that O'Donnell teaches each and every limitation of claim 72. As discussed in the enclosed Declaration Under 37 C.F.R. §1.132 by Dr. Greg Moeck, the skilled artisan would not readily conclude that the polypeptide of O'Donnell would bind to the polypeptide of SEQ ID NO:4. Indeed, as polypeptides are known in the art that self-regulate the activity of particular domains, through auto-inhibition, the carboxy-terminus of the polypeptide of O'Donnell may be blocked from binding to second polypeptide, such as that of SEQ ID NO:4.

As such, the Examiner has not established that the polypeptide of O'Donnell has the binding characteristics of the polypeptide of claim 72. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Appln. No. 10/025,222

Q79015

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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